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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/436,387 02/07/00 BARRETT

R P-4419.001

EXAMINER

PM82/0117

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ART UNIT

PAPER NUMBER

3662  
DATE MAILED:

01/17/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
**09/436,387**

Applicant(s)  
**Rolin F. Barrett, Jr.**

Examiner  
**Bernarr Earl Gregory**

Group Art Unit  
**3662**



☒ Responsive to communication(s) filed on 14 December 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three (3) month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-16 and 30-32 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☒ Claim(s) 1-16 is/are allowed.

☒ Claim(s) 30-32 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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1. This Office Action is in response to Applicant's Amendment B of 06 November 2000 and to the Response of 14 December 2000. It is noted that Applicant has argued that claims 30-32 do not recapture subject matter in that they are claims that are directed to distinct inventions. The examiner has been instructed that, "A claim to a different invention is one which inherently adds new limitations (e.g., different category of invention); however, that does not change the fact that a 'surrendered limitation' cannot be omitted in such a claim." Thus, the fact that claims 30-32 are directed to inventions that were not claimed in the original application (i.e., they are not patentable for the same reasons as the claims allowed in the patent) amounts to recapture under present USPTO policy.

2. Claims 1-16 are allowable over the prior art of record.

3. Claims 30-32 are rejected under 35 USC 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent on which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F. 3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F. 3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F. 2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application.

Accordingly, the narrow scope of the claims in the patent was not an error within the meaning

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of 35 USC 251, and the broader scope surrendered in the application for the patent can not be recaptured by the filing of the present reissue.

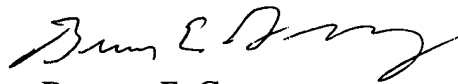
Each and every point argued by Applicants on the record as defining over the prior art applied in the rejections of record in the patent application as well as the points set forth in the Examiner's Statement of Reasons for Allowance must be contained in any claims to be issued in this reissue application. That is to say, whatever limitations in the patent application that made the allowed claims allowable over the applied prior art must be present in any claims issuing from this reissue application.

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bernarr Gregory whose telephone number is (703) 306-5765. The Art Unit FAX number is (703) 306-4195.



**Bernarr E. Gregory**  
**Primary Examiner**  
**Art Unit 3662**

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January 16, 2001